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ESCHWEILER & ASSOCIATES, LLC
NATIONAL CITY BANK BUILDING
629 EUCLID AVE., SUITE 1210
CLEVELAND, OH 44114

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OFFICE OF PETITIONS

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| In re Application of | : | |
| Subramanian et al. | : | DECISION ON APPLICATION |
| Application No. 09/634,302 | : | FOR |
| Filed: August 8, 2000 | : | PATENT TERM ADJUSTMENT |
| Attorney Docket No. E0796 | : | |

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b)," filed October 20, 2005. Applicants request that the initial Determination of Patent Term Adjustment under 35 U.S.C. 154(b) be corrected from one hundred ninety-one (191) days to one thousand eighty-nine (1089) days.

The application for patent term adjustment is **GRANTED to the extent indicated herein.**

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is **one thousand eighty-four (1084)** days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On September 30, 2005, the Office mailed a Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. Applicants were advised that the patent term adjustment to date is 191 days. In response, applicants timely¹ filed the instant request for reconsideration of the patent term adjustment along with payment of the fee set forth in 37 C.F.R. § 1.18(e). Applicants request that the patent term

¹ PALM Records indicate that the Issue Fee payment was received on November 14, 2005.

adjustment be corrected to 1089 days. Applicants assert that the Office's delay pursuant to 37 C.F.R. § 1.703(a)(2) should be calculated as 700 days, not 244 days. Further, applicants assert that no circumstances exist within the prosecution of this application that may be considered as resulting in a failure to engage in reasonable efforts to conclude examination of the present application.

Applicants state that the patent issuing from the application is not subject to a terminal disclaimer.

The application history has been reviewed and it has been determined that the initial patent term adjustment of 191 days is incorrect. The Office mailed an Office action under section 132 on November 18, 2003, four months and 244 days after the date of filing of applicant's reply, November 19, 2002. However, the Notice was not mailed to the correspondence address of record (but to an attorney not of record). The record supports a conclusion that this was due to an error on the part of the Office in mailing the Office action to applicants. Accordingly, a letter restarting the period for reply (and re-mailing the notice) was mailed on February 11, 2005.

Thus, the Office's delay should be calculating using the February 11, 2005. However, the period of delay is 695 days, not 700 days. In this regard, applicants' attention is directed to 37 CFR 1.703(f), which provides that "[t]he date indicated on any certificate of mailing or transmission under § 1.8 shall not be taken into account in this calculation" of patent term adjustment. See also, Comment 10, *Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule*, 65 Fed. Reg. 54366 (September 18, 2000). Applicants' response was received on November 19, 2002. Thus, the period of adjustment is 695 days, the number of days in the period beginning on the day after the date that is four months after the date a reply under § 1.111 was filed, March 20, 2003, and ending on the date of mailing of an action under 35 U.S.C. 132, February 11, 2005.

Under the circumstances, applicants are correct that they did not fail to engage in reasonable efforts within the meaning of § 1.704(b). Their response filed May 5, 2005, was received within three months of the mailing of the Office action as re-mailed on February 11, 2005. Accordingly, a period of reduction of 442 days should not have been entered.

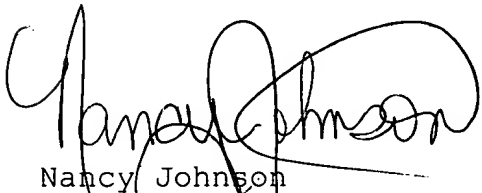
In view thereof, the correct patent term adjustment at the time of the mailing of the notice of allowance is 1084 days (389 + 695).

Submission of the \$200.00 fee set forth in 37 CFR 1.18(e) is acknowledged. No additional fee is required.

Applicants are reminded that any days of delay for Office issuance of the patent more than 3 years after the filing date of the application which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. Further, in considering the overlap, the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). See 35 U.S.C. 154(b)(1)(B); 35 U.S.C. 154(b)(2)(A); and 37 CFR 1.703(f).

The Publishing Division has been advised of this decision. The application is, thereby, being forwarded to the Publishing Division for issuance of the patent.

Telephone inquiries regarding this matter should be directed to the undersigned at (571) 272-3219.

A handwritten signature in black ink, appearing to read "Nancy Johnson", is written over the typed name.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of updated PAIR screen